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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,197	05/23/2000	Kia Silverbrook	NPA001US	9186

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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12/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/575,197

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,8-18,20-30 and 36-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-18,20-30 and 36-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/07/07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-3, 8-18, 20-30, and 36-47 are pending. Claims 1, 3, 29, 41, and 42 have been amended in this communication filed 09/17/07 entered as Response After Non-Final Action (Response to informal or non-responsive amendment).
2. The IDS filed 5/07/07 has been entered and considered.

### ***Claim Objections***

3. Claims 1 and 36 are objected to because of the following informalities: Claim 1 is in the improper method claim format. A method claim should begin with an "ing" verb. The claim limitation reciting "operatively positioning ...". This claim limitation should begin with "positioning an optically imaging pen operatively relative to the human-readable information;". Claim 36 needs a colon (: ) after "comprising" and before "an action". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 recites "sensing corresponding coincident coded data;". It is vague and unclear what or who is sensing the "coincident coded data". Is the imaging pen "sensing the coincident coded data"? Claim 2 recites "position of the sensing device ...". It is unclear in the claim limitation if the "sensing device is the "imaging pen" or

some other "sensing device". Claim 47 recites "... to cater for a bill ...". "Cater" is defined as "capture or chase". It is unclear what Applicants' mean by the term "cater".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser in view of "A.T. Cross Company", here after "A.T. Cross".

Claims 1 and 29. Speiser discloses, A method of enabling payment of bills, the method including the steps of: providing a bill, the bill containing human-readable information indicative of at least one parameter relating to a requested payment and coded data indicative of an identity of the bill and of a plurality of locations on the bill, at least some of the coded data being coincident with the information (page 6, paragraph 1- paragraph 3, and Fig. 1). Speiser failed to disclose, operatively positioning an optically imaging pen relative to the human-readable information; sensing corresponding coincident data; generating digital ink in the pen using the sensed coded data, said digital ink being a sequence of captured pen strokes, each stroke containing data indicative of the identity of the bill and a position of the pen relative to the bill; sending the digital ink to a computer system such that the computer system can identify the at least one parameter relating to the requested payment. "A.T. Cross" discloses, operatively positioning an optically imaging pen relative to the human-readable

information; sensing corresponding coincident data; generating digital ink in the pen using the sensed coded data, said digital ink being a sequence of captured pen strokes, each stroke containing data indicative of the identity of the bill and a position of the pen relative to the bill; sending the digital ink to a computer system such that the computer system can identify the at least one parameter relating to the requested payment (page 1, para. 1-page 2, para. 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Speiser with the teachings of "A.T. Cross" because such a modification would allow Speiser to know that the bill was paid in full and the consumer was given credit for paying the bill on time. The coded data being printed. Thus, the descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Claims 2 and 30. Speiser discloses, said at least one parameter relating to the requested payment is associated with at least one zone of the bill and in which the method includes identifying, in the computer system and from the zone indicated by the position of the sensing device as indicated by the digital ink, said at least one parameter (Page 6, paragraphs 3 and 4). "A.T. Cross" discloses "digital ink" (para. 1, para. 5).

Claims 3 and 31. Spieser discloses, wherein each stroke of the digital ink includes movement of the pen relative to the bill, the pen generating the movement data using at least some of the coded data. "A.T. Cross" discloses "digital ink" (page 2, para. 6 and 7).

8. Claims 8-14 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser and "A.T. Cross Company", hereafter "A.T. Cross", in view of (US 5,326,959) Perazza.

Claim 8. Spieser discloses, The method of claim 2 which the at least one parameter is an action parameter of the requested payment, the method including effecting, in the computer system, an operation in respect of the action parameter (Page 6, paragraph 1 and Page 7, paragraph 2).

Claims 9 and 37. Spieser discloses, the action parameter of the requested payment is selected from the group comprising: requesting that payment be made, specifying a payment amount or resetting the bill to an original state (Page 8, paragraph 1 (when the bill is generated there is a payment amount on the bill)).

Claim 10. Speiser and "A.T. Cross" failed to disclose, The method of claim 3 in which the at least one parameter is an option parameter of the requested payment, the method including identifying, in the computer system, that a hand-drawn mark has been entered on the bill by means of the pen and effecting, in the computer system, an operation associated with the option parameter. Perazza discloses, The method of claim 3 in which the at least one parameter is an option parameter of the requested payment, the method including identifying, in the computer system, that a hand-drawn mark has been entered on the bill by means of the pen and effecting, in the computer system, an operation associated with the option parameter (col. 16, lines 55-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify in Speiser with the teachings Perazza because such a modification

would allow Speiser to identify that a hand-drawn mark was present on the bill and made by a sensing device (pen).

Claims 11 and 38. Spieser discloses, the option parameter is associated with at least one of: cardholder name, payment method or credit card type (Page 8, paragraph 2 –payment method which can be any type of method).

Claim 12. Speiser and "A.T. Cross" failed to disclose, The method of claim 3 entered by means of the pen and effecting, in the computer system, an operation associated with the text parameter. Perazza discloses, The method of claim 3 entered by means of the pen and effecting, in the computer system, an operation associated with the text parameter (col. 16, lines 55-63).

Claim 13. Speiser and "A.T. Cross" failed to disclose, The method of claim 12 which includes converting, in the computer system, the handwritten text data to computer text. Perazza discloses, The method of claim 12 which includes converting, in the computer system, the handwritten text data to computer text (col. 16, lines 55-63).

Claims 14 and 39. Speiser and "A. T. Cross" failed to disclose, the text parameter is associated with at least one of: a cardholder name, an amount paid or a card expiry date. Perazza discloses, the text parameter is associated with at least one of: a cardholder name, an amount paid or a card expiry date (col. 16, lines 28-63).

9. Claims 15-18 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser, "A.T. Cross Company", hereafter "A.T. Cross" and (US 5,326,959) Perazza in view of (US 5,892,824) Beatson et al, hereafter Beatson.

Claim 15. Speiser, "A. T. Cross" and Perazza failed to disclose, The method of claim 3 in which the at least one parameter is an authorization parameter of the requested payment, the method including identifying, in the computer system, that a handwritten signature has been entered by means of the pen and effecting, in the computer system, an operation associated with the authorization parameter. Beatson discloses, The method of claim 3 in which the at least one parameter is an authorization parameter of the requested payment, the method including identifying, in the computer system, that a handwritten signature has been entered by means of the pen and effecting, in the computer system, an operation associated with the authorization parameter (col. 8, lines 41-52).

Claim 16. Speiser, "A.T. Cross", and Perazza failed to disclose, The method of claim 15 which includes verifying, in the computer system, that the signature is that of a particular person. Beatson discloses, The method of claim 15 which includes verifying, in the computer system, that the signature is that of a particular person (col. 8, lines 41-52). The Speiser, and Perazza patents lack a system that identifies that a hand-written signature has been entered by the sensing device and effecting the operation associated with the authorization parameter in claim 15 and the signature is that of a particular person in claim 16. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser and Perazza systems to include the teachings of the Beatson patent to make the systems more user friendly, faster, more efficient, and more secure.



Claims 17 and 40. Speiser and "A.T. Cross" failed to disclose, the authorization parameter is associated with payment authorization. Perazza discloses, the authorization parameter is associated with payment authorization (col. 16, lines 28-63).

Claim 18. Speiser and "A.T. Cross" failed to disclose, The method of claim 1, wherein the providing step includes receiving a request from a user to print the bill on demand, and printing the bill on demand. Perazza discloses, wherein the providing step includes receiving a request from a user to print the bill on demand, and printing the bill on demand (col. 6, lines 53-65).

10. Claims 20-28 and 36, 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over (GB 2226670A) Speiser, "A.T. Cross", Perazza, (US 5,892,824) Beatson et al, hereafter Beatson,, (W0 99/50787) Xerox, (US 5,673,430) Story, (US 5,673,430) Mallicoat, and (10/94562A) Japanese Patent Abstract (Solution Portion of Abstract).

Claims 20 and 45. Speiser, "A.T. Cross", Perazza, and Beatson failed to disclose, wherein the coded data is invisible. Xerox discloses, wherein the coded data is invisible (Page 8, lines 23-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modified the Speiser, "A.T. Cross", Perazza, and Beatson patents to have invisible data so as not to interfere with other visible markings on the bill.

Claim 21. Speiser and "A.T. Cross" failed to disclose, The method of claim 1 which includes retaining a retrievable record of each bill generated, each of the generated bills being receivable using its identity as contained in its coded data. Perazza discloses,

The method of claim 1 which includes retaining a retrievable record of each bill generated, each of the generated bills being receivable using its identity as contained in its coded data (col. 6, lines 53-65).

Claim 22. Speiser, "A.T. Cross", Perazza, Beatson, and Xerox failed to disclose, The method of claim 1 which includes distributing a plurality of the bills using a mixture of multicast and pointcast communications protocols. Story discloses, The method of claim 1 which includes distributing a plurality of the bills using a mixture of multicast and pointcast communications protocols (col. 3, lines 14-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, "A. T. Cross", Perazza, Beatson, and Xerox patents to use multicast and pointcast communications protocols to reduce the operating costs.

Claims 23 and 42. Speiser, "A. T. Cross", Perazza, Beatson, Xerox, and Story failed to disclose, the sensing device contains an identification means which imparts a unique identity to the pen and identifies it as belonging to a particular person and in which the method includes monitoring, in the computer system, said identity. Mallicoat discloses, the sensing device contains an identification means which imparts a unique identity to the pen and identifies it as belonging to a particular person and in which the method includes monitoring, in the computer system, said identity (col. 6, line 66-col. 7, line 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, "A.T. Cross", Perazza, Beatson, Xerox, and Story patents to include the teachings of the Mallicoat patent to provide a more accurate and informative reading from the bill.

Claim 24. Speiser and "A.T. Cross" failed to disclose, The method of claim 1 which includes providing all required information relating to the requested payment in the bill to eliminate the need for a separate display device. Perazza discloses, The method of claim 1 which includes providing all required information relating to the requested payment in the bill to eliminate the need for a separate display device (col. 6, lines 62-66).

Claims 25 and 47. Speiser, "A.T. Cross", Perazza, Beatson, Xerox, Story, and Mallicoat failed to disclose, the bill is printed on multiple pages and in which the method includes binding the pages. Japanese Patent Abstract discloses, the bill is printed on multiple pages and in which the method includes binding the pages (Solution Portion of Abstract).

Claim 26. Speiser and "A.T. Cross" failed to disclose, The method of claim 1 wherein: the step of providing the bill is done by sending the bill by mail. Perazza discloses, The method of claim 1 wherein: the step of providing the bill is done by sending the bill by mail (col. 3, lines 53-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, "A.T. Cross", Perazza, Beatson, Xerox, Story, and Mallicoat patents to have a means of binding a bill having multiple pages so that the various pages would remain together and reduce the opportunity for the pages to become separated or lost.

Claim 27. Speiser and "A.T. Cross" failed to disclose, The method of claim 1, further including the step of causing a printer to print a payment receipt after a payment has been completed. Perazza discloses, The method of claim 1, further including the step

of causing a printer to print a payment receipt after a payment has been completed (col. 6, lines 53-65).

Claims 28 and 44. Speiser and "A.T. Cross" failed to disclose, wherein the payment receipt comprises coded data indicative of the identity of the receipt. Perazza discloses, wherein the payment receipt comprises coded data indicative of the identity of the receipt (col. 6, lines 53-65).

Claim 36. Speiser and "A.T. Cross" failed to disclose, The system of claim 29 in which said at least one parameter of the requested payment is selected from the group comprising an action parameter of the requested payment, an option parameter of the requested payment, a text parameter of the requested payment, or an authorization parameter of the requested payment. Perazza discloses, The system of claim 29 in which said at least one parameter of the requested payment is selected from the group comprising an action parameter of the requested payment, an option parameter of the requested payment, a text parameter of the requested payment, or an authorization parameter of the requested payment (col. 16, lines 28-48).

Claim 41. Speiser, "A.T. Cross", Perazza, and Beatson failed to disclose, The system of claim 31 in which the pen includes a marking nib. Xerox discloses, The system of claim 31 in which the pen includes a marking nib (505, Page 14, lines 10-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the Speiser, Perazza, and Beatson patents to have a pen with a nib so that if marks are necessary on the bill, they can be made at the time of reading the bill with the sensing device.

Claim 43. Speiser and "A.T. Cross" failed to disclose, The system of claim 29 in which the bill is printed on a surface of a surface defining means and in which the system includes a printer for printing the bill on demand. Perazza discloses, The system of claim 29 in which the bill is printed on a surface of a surface defining means and in which the system includes a printer for printing the bill on demand (col. 6, lines 53-65).

Claim 46. Speiser and "A.T. Cross" failed to disclose, The system of claim 29 which includes a database for keeping a retrievable record of each bill generated, each bill being retrievable by using its identity as included in its coded data. Perazza discloses, The system of claim 29 which includes a database for keeping a retrievable record of each bill generated, each bill being retrievable by using its identity as included in its coded data (col. 7, lines 9-23).

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Masaki et al (US 5,159,321) discloses a pen-type computer input device with a pen nib disposed in the shank for detecting directions in which the distances of the pen nib move.

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 6, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER